

REMARKS

Applicants respectfully submit that the late-stage restriction requirement is improper given the related nature of the claims and the fact that these claims have been prosecuted together and have been searched together since May of 2004.

35 U.S.C. § 121 allows restriction when two or more “independent and distinct” inventions are claimed in the same application. As set forth in the MPEP, two claimed inventions are independent when they are without a disclosed relationship, that is when they are “unconnected in design, operation, and effect,” and are conversely related when they are connected in at least one of design, operation, or effect. (MPEP § 802.01, emphasis added) Two claimed inventions are distinct when they are “not connected in at least one of design, operation, or effect . . . and at least one invention is patentable . . . over the other.” (MPEP § 802.01, emphasis added)

As set forth in the MPEP, to establish a case for restriction, the PTO must at least show that two elements are met: “(A) [t]he inventions must be . . . distinct . . . and (B) [t]here would be a serious burden on the examiner if restriction is not required.” (MPEP § 803) As discussed below, Applicants traverse the Restriction between species on the grounds that one or both of the distinctiveness element and the burden element are not met.

Applicants respectfully traverse the Restriction on the grounds that the Examiner has not established a *prima facie* case that each of species is distinct one from another. In the Office Action, the Examiner indicated that the claimed inventions are distinct subcombinations disclosed as usable together in a single combination, citing MPEP § 806.05(d). That section indicates that restriction is only proper when there would be a serious burden on the Examiner if restriction were not required, as evidenced by separate classification, status, or field of search.

Applicant respectfully submits that there is no serious burden on the Examiner here, as evidenced by the fact that these claims have been examined together since May 2004.

The PTO has failed to establish the burden element for the identified species. As set forth in the MPEP, “[f]or purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search.” (MPEP §§ 803 and 808.02.) With regard to the identified species the PTO has merely alleged the need for a separate search, but has not indicated what separate search might be needed. Additionally, the allegedly separate classification provided by the Examiner is disingenuous as each set of claims can be readily applied for the other claims.

The Examiner identified Group I of claims as being classified in class 235, subclass 383, which is: “Registers – Systems controlled by data bearing records – Mechanized store.” This classification can equally be applied to the claims of Group II and Group III identified by the Examiner, as each independent claim from those Groups requires a vendor device, a purchaser device, and an authorization processor. The Examiner has not shown that the claims of Groups II or III cannot properly be classified in the class identified by the Examiner for Group I.

Additionally, the Examiner identified the class for Group II as being class 705, subclass 18, which is: “Data Processing: Financial, Business Practice, Management, or Cost/Price Determination – Automated electrical financial or business practice or management arrangement – Having security or user ID provision (password entry, etc.).” Again, this classification can equally be applied to the claims of Group I or Group III. The independent claims from these groups both similarly require transmitting a request for a purchase authorization and receiving a response that is then transmitted to the vendor from the purchaser device. Thus, the Examiner

has not shown that the claims of Groups I or III cannot properly be classified in the class identified by the Examiner for Group II.

In addition, the Examiner identified the class for Group III as being class 704, subclass 26, which is: “Data Processing: Financial, Business Practice, Management, or Cost/Price Determination – Automated electrical financial or business practice or management arrangement – Electronic shopping (e.g. remote ordering).” In similar fashion, this classification can be applied to the claims of Group I and Group II as easily as it can be applied to the claims of Group III. The independent claims from Groups I and II show electronic shopping to the same extent that the claims of Group III show electronic shopping. Thus, the Examiner has not shown that the claims of Groups I or II cannot properly be classified in the class identified by the Examiner for Group III.

Therefore, the Examiner has not shown anything that would indicate that there is a separate classification for the claims of the various identified Groups. Therefore, the Examiner has not established a need for a separate search beyond a bare unsupported allegation of a need for separate search (see Office Action at page 3 lines 3-5). As set forth above, these claims have been examined together since May 2004, providing additional evidence that there is no need for a separate search for the claims. For this reason alone, the restriction requirement should be withdrawn.

As discussed in the MPEP and above, claimed inventions are NOT distinct when they are connected in at least one of design, operation, or effect. (MPEP § 802.01) Furthermore, as discussed in the MPEP, “species must be patentably distinct from each other.” (MPEP § 806.04(h).) In the Office Action, the Examiner alleged that the various Groups of inventions are distinct because they are separately usable. The Examiner indicated that Group I has a separate

utility of obtaining and/or using an electronic coupon when making a purchase, that Group II has a separate utility of communication and management of electronic receipt information, and that Group III has a separate utility of a payment system that does not limit single transactions to a single account. The Examiner provided no support for these assertions of separate utility. To the extent that any claimed invention in any of the arbitrary Groups identified by the Examiner is capable of the utilities identified by the Examiner, the claimed invention of the other Groups is capable of performing the same utility.

For example, the Examiner identified no structure of the claims of Group I that provided the separate utility of obtaining/utilizing electronic coupons. Claim 28 never recites a coupon of any form, therefore, the device(s) for obtaining and utilizing electronic coupons must be the recited vendor device and purchaser device. However, claims 31 and 35 both include these devices and therefore have the same utility. As to claim 31's asserted ability to communicate and manage electronic receipt information, claim 28 specifically recites an electronic receipt (see preamble) and claim 35 recites "communicating a vendor identification and a purchase price for one or more items to the purchaser device via the wireless connection" which is clearly an electronic receipt. Both claims also recite similar devices as does claim 31. Therefore, claims 28 and 35 have the same utility as claim 31. As to claim 35's asserted ability to pay without limiting single transactions to a single account, this feature is also not recited in the claim and must be a feature of the recited devices, namely the purchaser device and vendor device similarly recited and providing the same utility in claims 28 and 31. Therefore, there is no separate utility between the various Groups of claims identified by the Examiner.

As further evidence that the restriction is arbitrary, Applicant refers to the grouping of claim 45 with Group III identified by the Examiner. Claim 45 depends from claim 31, placed in

Group II identified by the Examiner. Thus, to examine all the claims from Group III, the Examiner will have to also examine the independent claim from Group II. Therefore, there is no reduction in the burden on the Examiner, and there is no need to separate these claims that have been examined together for nearly three years into arbitrarily small groups of claims.

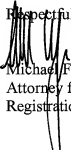
Therefore, because there is no showing of a burden on the Examiner by keeping the claims together and because the claims are not distinct as they have no separate utility not possessed by the other arbitrary groupings, Applicant respectfully submits that the restriction requirement is improper. Applicant therefore respectfully requests that the restriction requirement be withdrawn and that prosecution continue as to all claims 28-46.

CONCLUSION

Should there be further questions regarding this election with traverse or further impediments to the prompt examination of these claims, the Examiner is invited to contact the undersigned.

DATED this 5 day of April, 2007.

Respectfully submitted,


Michael F. Krieger
Attorney for Applicant
Registration No.: 35,232

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 321-4814
Facsimile: (801) 321-4893